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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/034,446 | 12/26/2001 | Rick K. Southern | D9426 | 1727 |

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07/11/2005

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EXAMINER

A, PHI DIEU TRAN

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/034,446 | Applicant(s) SOUTHERN ET AL. | |
| | Examiner Phi D. A | Art Unit 3637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,10,12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,10,12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/20/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is enabled for the adhesive having diisocyanate, not isocyanate

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is depended upon cancelled claim 13. It is thus indefinite and unclear as to the scope of the claim.

The claim is examined as best understood as depended upon claim 14 instead.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-7, 10, 12, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of Taylor et al (3740910) and Searer (5570554).

Greenway shows hardwood floor planks (page 2, col 2 lines 24-30) of at least about 3 feet (page 1 col 1 lines 26-29) onto a concrete surface and securing it with an adhesive, the floor having varying thickness at the grooves, the floorboards being prepared away from the installation site (inherently so as the boards formed elsewhere and then brought to the site for installation), the floorboard being provided with color (inherently so) and wormholes (6), nails (14) can be used in the wormholes (6) to fasten the board to the concrete at substantially right angle thereto through the board..

Greenway does not show the adhesive being water resistant, water impermeable adhesive, the boards being nailed to the concrete floor surface thereto through the boards and through the adhesive layer.

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Searer shows a hardwood floor plank boards being nailed to the concrete floor surface substantially at right angles thereto through the boards.

Taylor et al discloses a board (8) being secured to a substructure with nails (12) going through the boards and adhesives (14), the adhesive being water impermeable adhesive (col 1 lines 55-60), the nailing going through the board after the adhesive (14) has been applied to the boards (col 4 lines 54-57).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway to show the adhesive being water resistant, water impermeable adhesive as taught by Taylor et al, the boards being nailed to the concrete floor surface at right angles thereto through the boards as taught by Searer and through the adhesive layer because having the adhesive being water resistant water impermeable would prevent the adhesive from being damaged by water as taught by Taylor et al, and having nails going through floor boards to the concrete surface at right angles thereto through the boards and the adhesives would enable the adhesive to hold onto the boards while nailing the boards in positions and enable the adhesives to bond the boards in place upon drying without having to have a person holding the boards in place.

Per claims 1-3, 5-7, 10, 12, 16, and 19-20, Greenway as modified shows all the claimed limitations. The claimed method steps for attaching solid hardwood floor planks to a concrete surface would have been the obvious method of attaching Greenway's modified structures to a concrete surface.

Per claim 17, Greenway as modified shows the claimed method step of nailing nails into the surface features to hide the nails therein.

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Per claim 18, Greenway as modified shows the claimed method of nailing the floorboards to the concrete through the adhesive layer and the adhesive being allowed to set after the floorboards are nailed.

3. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenway (2088238) in view of Taylor et al (3740910) and Searer (5570554) as applied to claim 1 above and further in view of Murray (5951796).

Greenway as modified shows all the claimed limitations except for the adhesive comprising a moisture-curable polyurethane-based composition.

Murray discloses an adhesive for mounting tiles to concrete floor (col 8 example 1), or for mounting bricks to wall (col 8 example 3), the adhesive comprising a moisture-curable polyurethane-based composition (col 3 lines 32-39, col 6 lines 57-60, also since moisture is in the air most of the time, adhesives are considered moisture curable).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Greenway's modified structure to show the adhesive comprising a moisture-curable polyurethane-based composition as taught by Murray because the adhesive would fill voids or imperfections between construction material and having a rapid cure time as taught by Murray (col 3 lines 45-49).

Per claim 15, Murray as modified shows the adhesive comprising a prepolymer including a polyol and an isocyanate.

Response to Arguments

4. Applicant's arguments filed 4/20/05 have been fully considered but they are not persuasive.

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5. The supplemental declaration of Richard Hirsch under 37 CFR 1.132 filed 4/20/05 is insufficient to overcome the rejection of claims 1-3, 5-7, 10, 12 based upon Greenway, Searer, and Taylor as set forth in the last Office action because: the modification of the reference Greenway by Searer and Taylor enhances the teachings of Greenway and shows all the claimed limitations, the references are also analogous as explained in the previous office action; furthermore, Greenway as modified, can perform the functions as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to applicant's argument to Taylor et al, examiner would like to point out that the combination with the Taylor et al reference would enhance the teaching of Greenway's reference as stated above. Taylor et al teaches attaching a board to a substructure with nails and adhesives. The use of both nails and adhesive would secure the fastening of the board to the substructure. Taylor et al thus teach a way to secure a board and its substructure together. The argument is thus moot.

With respect to applicant's statement to Taylor et al not teaching floor planks attached to concrete surface to form a floor, examiner respectfully points out that the Taylor et al reference teach precisely what is needed for Greenway, which is a way of attaching a structure to its substructure. The argument is thus moot.

With respect to hydrostatic pressure, it is not claimed. The argument is thus moot.

With respect to applicant's argument that there is no need to use nails to attach the floorboard to the concrete ahead of time as disclosed by Taylor et al to that of attaching the board to the wall, examiner respectfully disagrees. As taught by Taylor et al, the use of nails before the adhesive dried is to make sure the board is at the precise desired position when the adhesive cures. Applying Taylor et al's teaching to Greenway's structure thus ensures that the floorboard would be fastened tightly onto the floor when the adhesive cures. The modification is thus motivated. The argument is thus moot.

With respect to applicant's argument that Taylor et al is not analogous, examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Taylor et al teaches a way of attaching a board to a substructure. Greenway teaches a way of attaching a board to a substructure and so does Searer. The references are analogous as they all teach a way of attaching a structure to a substructure. The argument is thus moot.

With respect to water resistant and impermeable and or moisture curable adhesive, Green as modified shows all the claimed limitations. As explained in the previous office action, Taylor et al teach the adhesives being waterproof. By definition in Webster Dictionary → waterproof = impervious to water; covered with a material to prevent permeation by water. As such, waterproof reads on applicant's water resistant, water impermeable properties. The argument is thus moot.

With respect to "warping", it is not claimed. The argument is thus moot.

The declaration of Joseph Grady of 4/29/04 was addressed in the previous office action, and hence not repeated here.

With respect to “moisture cured”, examiner would like to point out the following. First of all, the reference Greenway as modified shows the claimed adhesive. Secondly, there appears to be moisture in the air, most of the time. Unless in a controlled environment for very specific purpose, the environmental air has water content. The content/percentage of moisture may vary, but there is moisture. The adhesive disclosed in both Greenway, and Taylor et al are both for non-controlled environment, and able to cure. It is unclear what range of moisture content, applicant is referring to in “moisture curable”. There is no range being claimed. The argument is thus moot.

With respect to applicant's stated commercial success, examiner would like to point out that there is insufficient proof that the commercial success is based on the product or process. Per case laws of Joy Technologies Inv. V. Manbeck, In re Mageli 470 F.2d 1380, 176 USPQ305 (CCPA 1973), In re Nozmick 478 F.2d 1260, 178 USPQ 43 (CCPA 1973), proof must be provided, not just conclusory statements or opinions. Per In re Huang 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (fed. Cir. 1996), inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. The argument is thus moot.

With respect to Mr. Baugther's letter, it is unclear from reading the letter of how the incident is related to “nailing and gluing the floorboard to the concrete”. It is clear that he had a flooring problem due to many factors.

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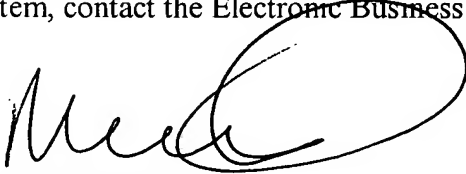
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows adhesive compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

7/7/05